

REMARKS

Reconsideration of this patent application is respectfully requested in view of the foregoing amendments and the following remarks. Claims 1, 3, and 5-38 are in the application. Claims 8 and 9 have been amended. Claims 5, 6, and 14-38 have been withdrawn from consideration. Claims 2 and 4 have been canceled. Claims 1, 3 and 7-13 are now being considered.

The Examiner rejected claims 8 and 9 under 35 USC 112, stating that it was unclear as to how the tool top part can form both the plastic film and the foam. Applicants have amended claim 8 to clarify that the tool top part used in forming the film is an auxiliary tool top part and is separate from the tool top part used in forming the foam. Support for this amendment can be found in the specification on page 21 and 36 and in the drawings, where the two tool top parts are given different reference numbers.

The Examiner rejected claims 1, 7, 10, 12, and 13 under 35 USC 103 as being unpatentable over Ericson in view of Malfliet et al and DeMoe et al. Claim 3 is rejected over these references and further in view of Jourquin. Applicants respectfully traverse.

Ericson discloses a method for producing a plastic part from a laminate material of a vinyl polymer film and a foam applied to the back. The production is simplified, by means of a certain viscosity of the vinyl polymer, a certain nozzle pressure, and a certain temperature, in such a manner that the vinyl polymer layer can be introduced into the mold using a spray device, and not, as was usual up to that time, placed into a mold in liquid form. Back-foaming is also disclosed.

In the entire reference, however, there is nothing to indicate any considerations regarding the surface of the plastic layer of vinyl polymer. In particular, there is no indication that divided dies, for example, and the resulting seams could represent a problem. Also, divided dies as such are not discussed in Ericson. The method of the invention does not even come to mind for a person skilled in the art upon reading Ericson.

The fact that an oven is mentioned in the production method disclosed by Ericson, into which the laminate plastic part is introduced, and in which it is supposed to be hardened/brought into gel form, does not provide any information regarding any desired and optional replacement of the oven with heating channels within a die that surrounds the laminate material. Here

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again, a person skilled in the art lacks any explanation why he/she should replace the method of oven heating with other means. The reasoning that in this way, the apparatus expenditure could be reduced by "reducing the amount of equipment" is erroneous. The formation of heating channels/heating pipes within a die mold, which must be movable, requires an enormous apparatus expenditure with regard to feed lines and pipelines, which are only justified because better heating or cooling can be achieved with this. In contrast, heating in an oven would be significantly easier to carry out.

With regard to the objections to claims 12 and 13, as explained in the previous response, the terms "paint film" are not even mentioned in Ericson. Combining Ericson with Malfliet et al. and DeMoe et al. to obtain the claimed invention is improper, because none of the references seek to address the specific features and object of the present invention.

When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references. See In re Geiger, 815 F.2d 686, 688, 2 U.S.P.Q.2d 1276, 1278 (Fed.Cir.1987). The suggestion to combine references may flow from the nature of the problem, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d

1568, 1573, 37 U.S.P.Q.2d 1626, 1630 (Fed.Cir.1996), or from the teachings of the references, see In re Sernaker, 702 F.2d 989, 994, (Fed.Cir.1983), or from the ordinary knowledge of those skilled in the art that the references are of special importance in a particular field, see Pro-Mold, 75 F.3d at 1573 (citing Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 297 n. 24, 227 U.S.P.Q. 657, 667 n. 24 (Fed.Cir.1985)). "When determining the patentability of a claimed invention which combines two known elements, 'the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.' " See In re Beattie, 974 F.2d 1309, 1311-12, 24 U.S.P.Q.2d 1040, 1042 (Fed.Cir.1992) (quoting Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 1462, 221 U.S.P.Q. 481, 488 (Fed.Cir.1984)).

The Examiner is required to show a motivation to combine the references that create the case of obviousness. In other words, the Examiner must show reasons why one of skill in the art, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited references for combination in the manner claimed in the present application. In re Rouffet, 149 F.3d 1350, 1357 (Fed.Cir. 1998); In re Kotzab, 217 F.3d 1365, 1371 (Fed.Cir.

2000).

The requirement of a suggestion to combine is a safeguard against the use of hindsight to negate patentability. While the skill level of those in the art is part of the inquiry for a suggestion to combine, a high level of skill alone does not supply a motivation to combine. Otherwise a high level of ordinary skill in an art field would almost always preclude patentable inventions. In re Rouffet, 149 F.3d at 1357 (Fed.Cir. 1998).

Since there is no teaching or suggestion in Ericson to combine the teachings of Malfliet or Devoe to achieve the present invention, which solves a completely different problem than that addressed by Ericson, Applicant submit that claims 1, 7, 10, 12 and 13 are patentable over the cited references, taken either singly or in combination.

The Examiner rejected claims 1, 8 and 9 under 35 USC 103 as being unpatentable over Greene in view of Malfliet et al, Ericson, and DeMoe et al. Claim 11 is rejected as being unpatentable over Greene, Malfliet, DeMoe and Staneluis et al. Applicants respectfully traverse.

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Greene describes a method in which an entire mold is produced from silicone, not a silicone skin that covers the actual mold in order to make the fine structure of the surface available. Seat cushions, etc., are produced using such a method. In the reference, the production of the mold as such is also described. See, for example Figures 1a-5a, with which the different production steps are shown. In the individual steps, a sample piece is covered with clay, step by step; the clay layers are removed, and afterwards, the remaining interstice is filled with silicone that is cast in.

Greene teaches that the entire mold, or significant surface parts of the mold, respectively, as such consist of silicone material. But neither this reference nor the other quotations from the state of the art give a person skilled in the art any incentive to configure this silicone mold as a thin skin and to cover a mold consisting of a different material with it, in order to solve the problems of seam formation between individual mold parts.

The introduction of a foam after the mold has been closed is not a generally known variant of a method in which introduction of the foam takes place first, followed by introduction of the top mold afterwards, namely after the foam has finished reacting.

Introduction of the foam after the mold has been closed specifically requires precise knowledge of the reaction and of the method of behavior during curing. Curing often results in problems in production and must be adapted accordingly.

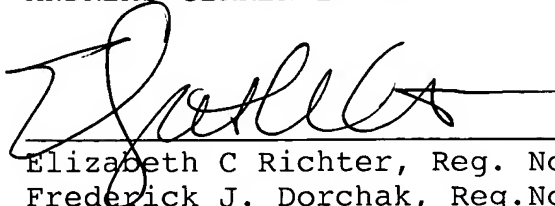
With regard to claims 8 and 9, Greene does not have any incentives that would bring a person skilled in the art to shape the surface skin of Greene using an inserted die, in order to adjust the precise layer thickness of the skin layer. Figures 5a-6b show the production method of that reference precisely, and teach a person skilled in the art specifically that no die at all is required for production of the skin layer 20.

Thus combining the teachings of Greene with Malfliet, Ericson or DeMoe is improper, as there is no suggestion in Greene that the problems solved by the present invention could be accomplished by combination with selective aspects of these patents.

Accordingly, Applicants submit that claims 1, 3 and 7-13 are patentable over the cited references, taken either singly or in combination. Early allowance of the amended claims is respectfully requested.

Respectfully submitted,

ANDREAS GERKEN ET AL.

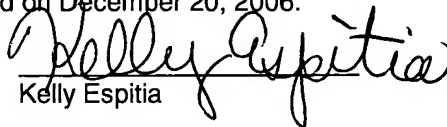


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